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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,382	09/30/2003	Corinne Bortolin	16222U-016700US	9159

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EXAMINER	
LASTRA, DANIEL	

ART UNIT	PAPER NUMBER
3688	

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02/16/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/676,382	BORTOLIN ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 21-42 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

Response to Amendment

2. In response to Non Final Rejection filed 06/22/09, the Applicant filed an Amendment on 10/22/09, which cancel claims 1-20 and added new claims 21-42.

Claim Objections

3. Claim 38 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-23, 25-26, 28-29, 32-33, 35-36, 38-39 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler (US 2002/0026348).

Claims 21, 32 and 38, Fowler teaches:

A method comprising: receiving information at one or more digital computers about a first pre-existing reward program created by a first merchant, wherein the first

pre-existing reward program provides for a first reward when a first product is purchased at the first merchant (see paragraphs 19-20);

receiving information at the one or more digital computers about a second pre-existing reward program created by a second merchant, wherein the second pre-existing reward program provides a second reward when a second product is purchased at the second merchant (see paragraph 31); and using the one or more digital computers, providing for a combination reward program that is linked to the first reward program and the second reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward program is provided by a host organization, wherein the first merchant is different than the second merchant (see paragraph 26-31), and wherein the combination reward is given to a consumer if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location (See paragraphs 26-31, 83).

Claim 22, Fowler teaches:

providing the combination reward to the consumer at the first merchant at the first location, wherein the combination reward can be used at the second merchant at the second location (see paragraph 105).

Claim 23, Fowler teaches:

wherein the portable consumer device is a smart card and wherein the combination reward is in the form of a coupon (see paragraph 40, 83).

Claim 25, Fowler teaches:

wherein the combination reward program is created by the host organization that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 26, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 28, Fowler teaches:

wherein the one or more digital computers comprises a server computer, and wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 28).

Claim 29, Fowler teaches:

wherein the first product and the second product are made by the same manufacturer (See paragraph 82 "brand").

Claim 35, Fowler teaches:

wherein the combination reward program is created by the host organization that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 36, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 39, Fowler teaches:

wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 53-54).

Claims 41-42, Fowler teaches:

wherein the combination reward is of greater value than the first reward or the second reward (See paragraph 75).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 24, 27, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Ryan (US 2005/0055272).

Claim 24, Fowler does not teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value

coupon) when said reward is offered in combination with another reward (i.e. joint a private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 27, 34 and 37, Fowler does not teach:

wherein the combination reward gives the consumer access to a special program earlier than another consumer that has not purchased the first product and the second product. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value coupon) when said reward is offered in combination with another reward (i.e. joint a private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. Claims 30-31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Postrel (US 6,594,640).

Claims 30-31, Fowler teaches:

wherein the portable consumer device is a smartcard (see paragraph 83) but does not expressly teach that conforms to ISO standard 7816, wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards. However, Postrel teaches that it is old and well known in the promotion art to stored rewards from a loyalty program in smart cards (see col 9, lines 55-65) and Official Notice is taken that it is old and well known to have smart cards that conforms to ISO standard 7816. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would store rewards on smart cards, as taught by Postrel that conforms to ISO standard 7816, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

7. Applicant's arguments filed 10/22/09 have been fully considered but they are not persuasive. The Applicant argues that Fowler teaches away from Applicant's claimed invention because the merchants in the claimed invention can unexpectedly obtain increased sales without modifying their pre-existing programs and without collaborating

to create a custom award program. The Examiner answers that the Applicant is arguing about limitation not stated in the claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT A WEINHARDT can be reached on (571)272-6633. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688
February 7, 2010